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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,923	11/06/2001	H. Darrel Darby	A7971	4566

7590 06/06/2005

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

PHAM, HUONG Q

ART UNIT PAPER NUMBER

3764

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,923

Applicant(s)

DARBY, H. DARREL

Examiner

Huong Q. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005 and 18 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6- 8, 10-14, 16 -22 are rejected under 35 U.S.C. 102(b) as being anticipated by Grim et al (5,761, 834).

As for claim 1, Grim et al teaches every claimed feature of claim 1 including an outer sole 78 (figure 3), a rigid immobilization plate (figure 2, reference # 14) including a bottom portion attached to a top of the outer sole 78, the bottom portion having a back end, and a back portion formed by a back part that extends up from the back end of the bottom portion and side parts that extend up from sides of the bottom portion, the back part being integrally formed with the side parts; and a boot portion 20 attached to the

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rigid immobilization plate. As for claims 6-8, note liner 52 in figure 2. As for claim 10, note figure 1. As for claim 11, note the lower removable insole 64, and an upper removable insole 66 (figure 3). As for claim 12, note figure 3. As for claim 13, note the boot portion 20 (figure 1) further comprises a circumferential counter for providing a pocket for the removable insoles. As for claim 16, note liner in figure 4. As for claims 19-22, note the strap 28 and means 16, 30 in figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim et al in view of Oster et al.

As for claims 2-3, 5, 15, note that the boot portion of Oster et al has ventilation ports 63. The provision of raised ventilation port to a shell or structure to provide better ventilation is well known, and does not provide any unobvious result, and therefore is not patentable. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide raised ventilation port to any structure to provide better ventilation. As for claim 4, note that the rigid immobilization plate 30 of Oster et al has ventilation port (figure 2).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grim et al.

The use of polyurethane material for a boot portion is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyurethane material for the boot of Grim et al. The substitution of one semi-flexible material for another semi-flexible material based on its well known characteristics is well within the realm of the artisan of ordinary skill, and does not provide any unobvious result, and therefore is not patentable over prior art.

Claims 23- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim et al in view of Darby et al (5,370,133) .

Note the comments above for the teaching of Grim et al. While Grim et al does not teach the recited fastening means of claims 20-28, Darby et al teaches this type of fastening means for a brace. In view of the teaching of Darby et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the fastening means of Grim et al with the fastening means of Darby et al. The substitution of one type of fastening means for another well-known type of fastening means in the art is a matter of obvious engineering design choice, and does not provide any unobvious result, and therefore is not patentable over prior art.

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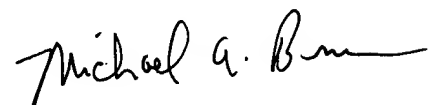
Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272 - 4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 13, 2005



MICHAEL A. BROWN
PRIMARY EXAMINER